



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,693	01/28/2004	Robert C. Huber	59972-299122	2072
25764 7590 03/31/2008 FAEGRE & BENSON LLP PATENT DOCKETING 2200 WELLS FARGO CENTER 90 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-3901				
EXAMINER				
PARK, GEORGE M				
ART UNIT		PAPER NUMBER		
3623				
MAIL DATE		DELIVERY MODE		
03/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,693

Applicant(s)

HUBER, ROBERT C.

Examiner

GEORGE PARK

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 4/24/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: The sentence "...U.S. Provisional Application No. **60/433,131**..." (page 1, paragraph [0001] and page 3, paragraph [0010]) should be -- ...U.S. Provisional Application No. **60/443,131**... --. Also, the sentence "...developing a tracking plan by which a **tracking entity** that is to retrieve the at least one asset..." (page 2, paragraph [0008], lines 7-8) should be --...developing a tracking plan by which a **retrieval entity** that is to retrieve the at least one asset...-- Appropriate correction is required.

Claim Objections

2. Claims 18 and 23 are objected to because of the following informalities: Regarding claim 18, the sentence in step (d) "developing a tracking plan by which a **tracking entity** that is to retrieve the at least one asset..." should be -- developing a tracking plan by which a **retrieving entity** that is to retrieve the at least one asset...--. Also, claim 23 should be numbered as claim 22. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 6-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being unpatentable by Wold et al. ("Disaster Proof Your Business", 1991).

Regarding to claim 6, Wold et al. discloses a method for reducing adverse effects upon a business or recovering business activities in an event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business, comprising (page 25, paragraph 1): (a) carrying out research regarding the business (page 30, last paragraph); (b) identifying risks of a disaster or disruption to the business (i.e. risk assessment) (page 89, paragraph 1, page 90, see exhibit 7); (c) identifying computer-related assets used in the business (i.e. equipment) (page 103, see "Determining Critical Needs" section, last sentence); and (d) developing an event plan (i.e. recovery plan) that is to be executed in the event of the disaster or disruption (page 175, paragraph 1), wherein the plan is based specifically on the business, at least one of the identified risks (i.e. disaster scenarios), and at least one of the identified computer-related assets (i.e. equipment) (page 179, see "Scope" section and "Typical Planning Assumptions" section).

Regarding to claim 7, Wold et al. discloses training team members as to their roles within the plan (page 32, question 2, page 226, paragraph 1).

Regarding to claim 8, Wold et al. discloses wherein the step of training team members comprises training team leaders as to how to communicate with each other and their respective team members during or after the disaster or disruption (page 226, paragraph 1, page 104, fifth bullet, page 205, section b: "Establishing the Command and Control Center").

Regarding to claim 9, Wold et al. discloses carrying out at least one simulated event (page 226, paragraph 2 under “Developing Testing Criteria and Procedures” section, page 227, “Simulation Testing” section)

Regarding to claim 10, Wold et al. discloses adjusting the plan (i.e. update/modification) during or after carrying out the at least one simulated event (page 231, paragraph 1 under “Evaluate the Test Results and Update the Plan” section)

Regarding to claim 11, Wold et al. discloses setting up a contingency organization that would be instituted at the time of the event (page 180, bullet “o”, page 200, section IV, bullet a).

Regarding to claim 13, Wold et al. discloses the event plan (i.e. recovery plan) comprises a plan to do at least one of recovering at least one aspect of the business (i.e. business recovery team, departmental recovery team, computer recovery team, etc.) (page 175, paragraph 1, page 181, see last paragraph) .

Regarding claim 14, Wold et al. discloses wherein the step of carrying out research comprises interviewing personnel (i.e. questionnaire) knowledgeable of one or more aspects of the business or the risks of a disaster or disruption to better understand the business and the risks (page 104, middle paragraph).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wold et al. ("Disaster Proof Your Business", 1991) in view of Toigo ("Disaster Recovery Planning", second edition, 2000) and further in view of Grant et al. ("Crisis Response & Communication Planning Workbook", June 1999, revised January 2000)

Regarding to claim 1, Wold et al. discloses the invention substantially as claimed. Wold et al. discloses a method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business (page 25, paragraph 1), comprising: (a) carrying out research regarding the business and risks of a disaster or disruption (i.e. risk assessment) (page 30, last paragraph, page 89, paragraph 1); (b) interviewing (i.e. questionnaire) personnel knowledgeable of one or more aspects of the business or the risks of a disaster or disruption to better understand the business and the risks (page 104, middle paragraph); (c) training team leaders as to what to do in the event of the disaster or disruption (page 32, question 2, page 226, paragraph 1) and how to communicate with each other and their respective team members during or after that disaster or disruption (page 104, fifth bullet, page 181, tenth bullet - "communications team", page 205, section b: "Establishing the Command and Control Center"); (d) training team members specific to their areas of responsibility (page 188, section VI, bullet b, section VII, bullet b and section VIII, bullet b, page 226, paragraph 1: "special and critical skills"); (f) carrying out simulated events (page 226, paragraph 2 under "Developing Testing Criteria and Procedures" section, page 227, "Simulation Testing" section); and (g) setting up a contingency organization (i.e. contingency staff) that would be instituted at the time of the event (page 180, bullet "o", page 200, section IV, bullet a). However, Wold et al. does not disclose (e)

estimating time to recover or gain access to servers and applications taking into consideration effects of dependencies of one server or application on another server or application and (h) planning for support services for team leaders and team members who would assist with maintaining business continuity or recovering the business. Toigo discloses (c) estimating time to recover or gain access to servers and applications taking into consideration effects of dependencies of one server or application on another server or application (i.e. timetable) (page 42, paragraph 2, page 44, paragraph 2, page 62, third to last paragraph). Grant et al. discloses (h) planning for support services (i.e. identification and location of resources) for team leaders and team members who would assist with maintaining business continuity or recovering the business (page 6, section 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Wold et al. with the feature of (c) estimating time to recover or gain access to servers and applications taking into consideration effects of dependencies of one server or application on another server or application and (h) planning for support services for team leaders and team members who would assist with maintaining business continuity or recovering the business as taught by Toigo and Grant et al., as Wold et al., Toigo and Grant et al. are directed to the method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster or to other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business. The motivation for doing so would have been to determine the impact and tolerance of the business if the business is interrupted for a period of time and to aid the team members maintain business continuity by having support services readily available.

Regarding to claim 2, Wold et al. and Toigo discloses the invention substantially as claimed. However, Wold et al. and Toigo do not disclose wherein support services comprises daycare services. Grant et al. discloses identifying support services (i.e. resources) that would be needed during a crisis including government resources. It is common knowledge in the prior art for government resources to include daycare services. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Wold et al. and Toigo et al. with the feature of wherein support services comprises daycare services as taught by Grant et al., as Wold et al., Toigo et al. and Grant et al. are directed to the method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business. The motivation for doing so would have been to aid team members in maintaining business continuity during the event of a disaster by having support services readily available for them such as daycare services for their children.

Regarding to claim 3, Wold et al. discloses wherein setting out a contingency organization comprises creating a contingency organizational chart and communicating that authority is given to the organization in the event of a disaster or disruption event (page 181, paragraph 2, page 200, section IV, bullet a).

Regarding to claim 4, Toigo discloses wherein at least one of the steps is at least partially completed using a computer (i.e. online) (page 41, second to last paragraph).

Regarding to claim 5, Wold et al., Toigo and Grant et al. discloses the invention substantially as claimed. However, Wold et al., Toigo and Grant et al. do not explicitly discloses wherein steps (a) through (h) are carried out in order. Moreover, this specific arrangement

claimed by Applicant is considered to be the equivalent to mere rearrangement of parts and is not considered to be patentably distinct from the prior art. See *In re Japikse*, 86 USPQ 70, 73; 182 F2d 207 (CCPA 1950). Also, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. Simply rearranging known steps in different combinations given the known functionality of each of steps (a)-(h) would have been obvious for one of ordinary skill in the art at the time of the invention to try so as to determine if one step proved more efficient than the other in terms of preparation in the event of a disaster to a business.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wold et al. ("Disaster Proof Your Business", 1991) in view of Grant et al. ("Crisis Response & Communication Planning Workbook", June 1999, revised January 2000).

Regarding to claim 12, Wold et al. discloses the invention substantially as claimed. However, Wold et al. does not explicitly disclose wherein the business continuity plan further comprising planning for support services for team leaders and team members who would assist with maintaining business continuity or recovering the business. Grant et al. discloses planning for support services (i.e. identification and location of resources) for team leaders and team members who would assist with maintaining business continuity or recovering the business (page 6, section 3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Wold et al. with the feature of wherein the business continuity plan further comprising planning for support services for team leaders and team members who would assist with maintaining business continuity or recovering the

business as taught by Grant et al., as Wold et al. and Grant et al. are both directed to the method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business. The motivation for doing so would have been to aid team members in maintaining business continuity by having support services readily available.

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wold et al. ("Disaster Proof Your Business", 1991) in view of Toigo ("Disaster Recovery Planning", second edition, 2000).

Regarding to claim 15, Wold et al. discloses the invention substantially as claimed. However, Wold et al. does not explicitly disclose wherein the step of identifying computer-related assets comprises identifying software applications and servers used in the business. Toigo discloses wherein the step of identifying computer-related assets comprises identifying software applications and servers (i.e. hardware, databases, etc.) used in the business (page 41, paragraph 1 under "Identifying and Prioritizing Assets and Functions" section). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Wold et al. with the feature of wherein the step of identifying computer-related assets comprises identifying software applications and servers used in the business as taught by Toigo, as both Wold et al. and Toigo are directed to the method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business. The motivation for doing so would have been to specifically

identify computer-related assets used in the business such as software applications and servers to determine resource requirements and the impact of the business in an event of a disaster.

Regarding claim 16, Wold et al. discloses the invention substantially as claimed. However, Wold et al. does not disclose estimating an amount of time to recover or gain access to computer-related assets. Toigo discloses estimating an amount of time to recover or gain access to computer-related assets (i.e. timetable) (page 44, paragraph 2, page 62, third to last paragraph). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Wold et al. with the feature of estimating an amount of time to recover or gain access to computer-related assets as taught by Toigo, as both Wold et al. and Toigo are directed to the method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business. The motivation for doing so would have been to determine the impact and tolerance of the business if the business is interrupted for a period of time.

Regarding to claim 17, Wold et al. discloses the invention substantially as claimed. However, Wold et al. does not disclose wherein the estimating step comprises taking into consideration including the effects of dependencies of at least one server or application on another server or application. Toigo discloses taking into consideration the effects of dependencies between business process and its infrastructure supports (i.e. server, application, etc.) (page 42, paragraph 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Wold et al. with the feature of wherein the estimating step comprises taking into consideration including the effects

of dependencies of at least one server or application on another server or application as taught by Toigo, as both Wold et al. and Toigo are directed to the method for reducing adverse effects upon a business or a recovering business activities in the event of a disaster to or other disruption of use of facilities, systems, materials, personnel, or other aspects of or relating to the business. The motivation for doing so would have been to determine the overall recovery time regarding the business processes and related infrastructures critical to the business as a whole, and not the recovery time of individual computer-related assets in an event of a disaster.

9. Claims 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. (U.S. Pat. No. 6,806,813 B1) in view of Schmidt et al. (U.S. Pat. No. 7,005,980 B1).

Regarding claim 18, Cheng et al. discloses the invention substantially as claimed. Cheng et al. discloses a method for maintaining or regaining at least partial activities of a business following an event that prevents or impedes access to at least one asset used in the business (i.e. tracking assets) (column 1, lines 14-20), comprising: (a) identifying where within a facility the at least one asset is located (i.e. tracking) (column 1, lines 14-20, column 2, lines 34-35); and (b) creating a description of the location of the at least one asset (i.e. location information) (column 1, lines 60-63). However, Cheng et al. does not disclose (c) developing a retrieval plan by which a retrieving entity would retrieve the at least one asset; and (d) developing a tracking plan by which a retrieval entity that is to retrieve the at least one asset is tracked during retrieval by a tracking entity. Schmidt et al. discloses (c) developing a retrieval plan (i.e. rescue method, protocols, etc.) by which a retrieving entity (i.e. firefighter) would retrieve the at least one asset (i.e. victim) (column 1, lines 32-34, column 3, lines 39-44, column 5, lines 9-14); and (d)

developing a tracking plan (i.e. track and pinpoint) by which a retrieval entity (i.e. firefighter) that is to retrieve the at least one asset is tracked during retrieval by a tracking entity (column 6, lines 22-24 and lines 42-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Cheng et al. with the feature of (c) developing a retrieval plan by which a retrieving entity would retrieve the at least one asset; and (d) developing a tracking plan by which a retrieval entity that is to retrieve the at least one asset is tracked during retrieval by a tracking entity as taught by Schmidt, as both Cheng et al. and Schmidt are directed to the method for maintaining or regaining at least partial activities of a business following an event that prevents or impedes access to at least one asset used in the business. The motivation for doing so would have been to safely recover the at least one asset in an event of a disaster.

Regarding claim 19, Cheng et al. discloses wherein the step of creating a description comprises creating a diagram (i.e. map) that shows the location of the at least one asset (column 1, lines 64-66 to column 2, lines 1-4, see fig. 6).

Regarding to claim 20, Cheng et al. discloses the invention substantially as claimed. However, Cheng et al. does not disclose wherein the tracking plan comprises the retrieving entity taking the retrieved asset to a location at which it may be used or kept for storage or future use. Schmidt et al. discloses retrieving assets (i.e. victims, non-human applications) in an event of a disaster (column 3, lines 39-44). It is common knowledge in the prior art for the retrieving entity (i.e. firefighter) to take the retrieved asset to a non-threatening location. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Cheng et al. with the feature of wherein the tracking plan comprises the

retrieving entity taking the retrieved asset to a location at which it may be used or kept for storage or future use as taught by Schmidt et al. as both Cheng et al. and Schmidt et al. are directed to the method for maintaining or regaining at least partial activities of a business following an event that prevents or impedes access to at least one asset used in the business. The motivation for doing so would have been to rescue and/or salvage the asset in order to maintain continuity of the business.

Regarding to claim 21, Cheng et al. discloses the invention substantially as claimed. However, Cheng et al. does not disclose wherein the tracking plan comprises providing communications between the tracking entity and the retrieving entity during retrieval. Schmidt et al. discloses providing communications (i.e. audio and/or video receiver) between the tracking entity and the retrieving entity during retrieval (i.e. rescue) (column 3, lines 30-33, column 6, lines 42-43). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Cheng et al. with the feature of wherein the tracking plan comprises providing communications between the tracking entity and the retrieving entity during retrieval as taught by Schmidt et al., as both Cheng et al. and Schmidt et al. are directed to the method for maintaining or regaining at least partial activities of a business following an event that prevents or impedes access to at least one asset used in the business. The motivation for doing so would have been to determine the status of the retrieval process of the asset between the retrieving entity and tracking entity.

Regarding to claim 22, Cheng et al. discloses the invention substantially as claimed. However, Cheng et al. does not disclose wherein the retrieving and tracking entities are humans. Schmidt et al. discloses wherein the retrieving and tracking entities are humans (i.e. firefighters,

rescue team, etc.) (column 5, lines 9-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the method of Cheng et al. with the feature of wherein the retrieving and tracking entities are humans as taught by Schmidt et al., as both Cheng et al. and Schmidt et al. are directed to the method for maintaining or regaining at least partial activities of a business following an event that prevents or impedes access to at least one asset used in the business. The motivation for doing so would have been to retrieve the asset more efficiently and effectively by using human abilities.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davenport et al. (U.S. Pub. No. 2004/0103431 A1) discloses a method and system for emergency planning and management of a facility. Breslin et al. (U.S. Pub. No. 2004/0064436 A1) disclose a system and method for managing business continuity. Herring (U.S. Pat. No. 6,069,570) discloses an asset location system. Jacobsen et al. (U.S. Pat. No. 6,198,394 B1) discloses a system for remotely monitoring personnel status. Janky et al. (U.S. Pat. No. 5,552,772) discloses a method and apparatus for monitoring the location of emergency service workers. Larsen (U.S. Pat. No. 7,134,088 B2) discloses a method and system for storing and retrieving tactical information pertaining to a site during crisis situation. Whalen, Jr. et al. (U.S. Pat. No. 6,029,889) discloses an accountability system for keeping track of firefighters at a fire scene.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GEORGE PARK whose telephone number is (571)270-3547.

The examiner can normally be reached on Monday - Friday (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. P./
Examiner, Art Unit 3623
3/27/2008
/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623